

AMENDMENT UNDER 37 C.F.R. § 1.116
U.S. Application No. 08/898,853

combined diameter of 35.0 to 39.5 mm, and said outer layer, said inner layer, and said intermediate layer have a combined diameter of 37.5 to 41.0 mm.

No 14 6
16. The solid golf ball according to claim 13, wherein a weight distribution in said solid core is designed so that said inner layer has a large specific gravity, and said intermediate layer and said outer layer have specific gravities which are smaller than said specific gravity of said inner layer.

C 3
17. The solid golf ball according to claim 13, wherein said solid core is formed by using a rubber composition comprising a base material composed of natural and/or synthetic rubber.

Surf E
18. The solid golf ball according to claim 13, wherein at least one layer of said solid core is formed by using a material comprising one selected from ionomer resins and thermoplastic elastomers composed of styrene, olefin, urethane, ester, or amide.

19. The solid golf ball according to claim 13, wherein said cover is formed by using an ionomer resin or a material containing it.--

REMARKS

This Amendment is submitted in response to the Office Action of February 23, 1999, in the above-referenced application.

By this Amendment, Applicant hereby reprints claims 1-12 pending in the present application pursuant to the Examiner's request on page 3 of the Office Action. In

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addition, Applicant has added additional claims 13-19, which have been copied verbatim from U.S. Patent No. 5,743,816 which issued to Ohsumi et al. on April 28, 1998 (copy attached). Ohsumi et al. has a U.S. filing date of March 27, 1997, which is after the effective U.S. filing date of June 13, 1996¹ of the present application. Thus, Ohsumi et al. is not prior art against the present application.

Applicant is in the process of preparing papers under 37 C.F.R. § 1.607, seeking to provoke an Interference between the claims of the present application and those in the '816 patent. Applicant expects to submit those papers within about a month. In the meantime, should the Examiner have any questions regarding this application, he is respectfully requested to contact the applicant's representative at the local telephone exchange listed below.

As a further initial matter, Applicant submits herewith a PTO Form 1449 listing the '816 patent for the Examiner's convenience.

Turning now to the merits of the February 23, 1999, Office Action, Applicant responds as follows.

Regarding the proposed drawing amendments filed on October 28, 1998, the Examiner contends that every feature of the claimed invention are not illustrated. The

¹ The present application is a continuation of U.S. Patent Application Serial No. 08/661,778, filed June 13, 1996 (now U.S. Patent No. 5,688,595).

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Examiner makes specific reference to claim 5 and the surrounding layer hardness of D 45 as not being indicated in the proposed drawing amendments. In response, Applicant submits herewith a further revision to Figure 2 for the Examiner's consideration. The proposed changes are shown in red ink. As can be seen, the surrounding layer 13 has been indicated as having a Shore D hardness of at least 45 degrees. Applicant respectfully submits that this should obviate the proposed drawing objections and withdrawal of the objection is respectfully requested.

Not 50
→ 45
etc (values)
45

Turning now to the rejection of claims 1-12, the Examiner contends that these claims are rejected under § 102(a) or (c) as being anticipated by Higuchi et al. (U.S. Patent No. 5,702,311). However, Applicant believes that the proper rejection should be based on § 102(e) rather than sub-sections (a) or (c). That is, the '311 patent did not issue until after the effective U.S. filing date (June 13, 1996) of the present application. Thus, the '311 patent cannot constitute prior art under 35 U.S.C. § 102(a). Sub-section (c) of 35 U.S.C. §102 deals with abandonment, and clearly this is not an issue. Accordingly, believes that the rejection is only proper under 35 U.S.C. § 102(e).

To address this rejection and remove the '311 patent as prior art, Applicant submits herewith a verified English translation of its priority document to perfect the claim to priority and remove Higuchi et al. as competent prior art to the application. Therefore, reconsideration is respectfully requested.

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As indicated above, Applicant will file a submission under Rule 607 seeking to provoke an Interference between the claims of the present application and those in the '816 patent. Claims 13-19, which have been added by this Amendment, correspond identically to claims 1-7 of the '816 patent.

Referring to newly added claim 13, Figure 2 of the present application illustrates a solid four-piece golf ball including a core 11 and cover 14. Figure 2 is described in more detail beginning on page 5 of the present application; examples of preferred embodiments according to the present invention are described beginning on page 9 and summarized in Table 1 on page 11.

Figure 2 of the present application illustrates a four-piece golf ball 10 having an inner sphere 12, a layer 13 surrounding the inner sphere 12, a layer 15 surrounding layer 13 and a layer 16 surrounding layer 15. The golf ball 10 is described as having a solid core 11 having at least two layers including layers 12, 13, and a cover 14 around the core including the layers 15 and 16. The characterization of whether the core includes two layers and the cover includes two layers or the core includes three layers and the cover includes one layer is one of choice.

The golf ball as disclosed in Figure 2 and described in the written specification of the present application includes layer 12 which corresponds to the "inner layer" defined in claim 13. The Shore D hardness of the layer 12 is ^{white in the spec} within the range of 20 to 55

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degrees. Figure 2 also illustrates a layer 13 which corresponds to the "intermediate layer" claimed in claim 13. This layer 13 as described in the present application has a Shore D hardness between 45 and 80 degrees. (See, page 7 of the present application.) Lastly, the "outer layer" defined in claim 13 refers to the layer 15 which is referred to as the inner cover layer in the present application. The layer 15 has a Shore D hardness in the range of at least 53 degrees, but less than the Shore D hardness of the intermediate layer or layer 13. See, page 7, lines 14-19, where it is described that the hardness of the layer 13 ("intermediate layer" in claim 13) should be greater than the hardness of the inner cover layer 15 ("outer layer" in claim 13) and greater than the layer 12 ("inner layer" in claim 13).

Page 6, line 30 provides written support for newly added claim 14, which recites that the inner layer or inner sphere 12 has a Shore D hardness of 15 to 40.

The addition of claim 14 to the present application is supported by the description beginning on page 7 of the present application, which describes the diameters of layers 12, 13 and 15.

As to claim 15, the materials are similar and therefore the present application provides the necessary support of the recited specific gravities. In other words, having an inner layer with a large specific gravity compared to the specific gravities of the

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intermediate and outer layers is inherent in the types of materials that these layers are formed of.

Claim 16 recites that the solid core is formed by using a rubber composition comprising a base material composed of natural and/or synthetic rubber, which is clearly satisfied by the present application (see page 6).

Page 10 of the specification describes that the surrounding layer may be made of a thermoplastic resin, which would satisfy the limitations of claim 17 which requires at least one layer of the core to be formed by using a material selected from ionomer resins and thermoplastic elastomers.

Lastly, the outer cover layer 16 of the present application is constructed from a blend of Himilan 1650/Surlyn 8120, which are a form of an ionomer resin material.

Based on the foregoing, Applicant respectfully submits that there is sufficient support in the written description of the present application to copy all of the claims of the '816 patent.

Consideration of this Amendment is respectfully requested. Should there be any questions, the Examiner is requested to contact the undersigned attorney at the local telephone exchange listed below.

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Applicant hereby petitions for any extension of time which may be required to maintain the pendency of this case, and any required fee, except for the Issue Fee, for such extension is to be charged to Deposit Account No. 19-4880.

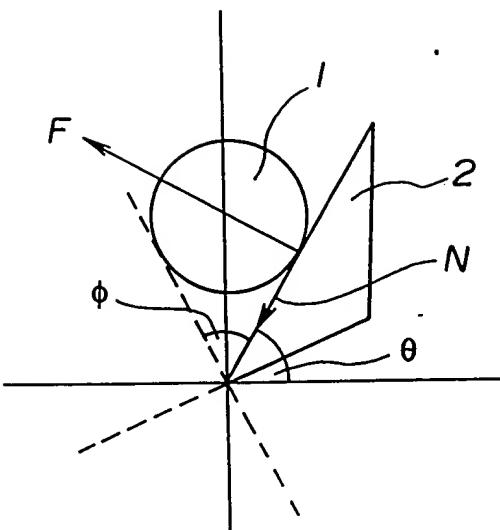
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Date: April 27, 1999

FIG.1

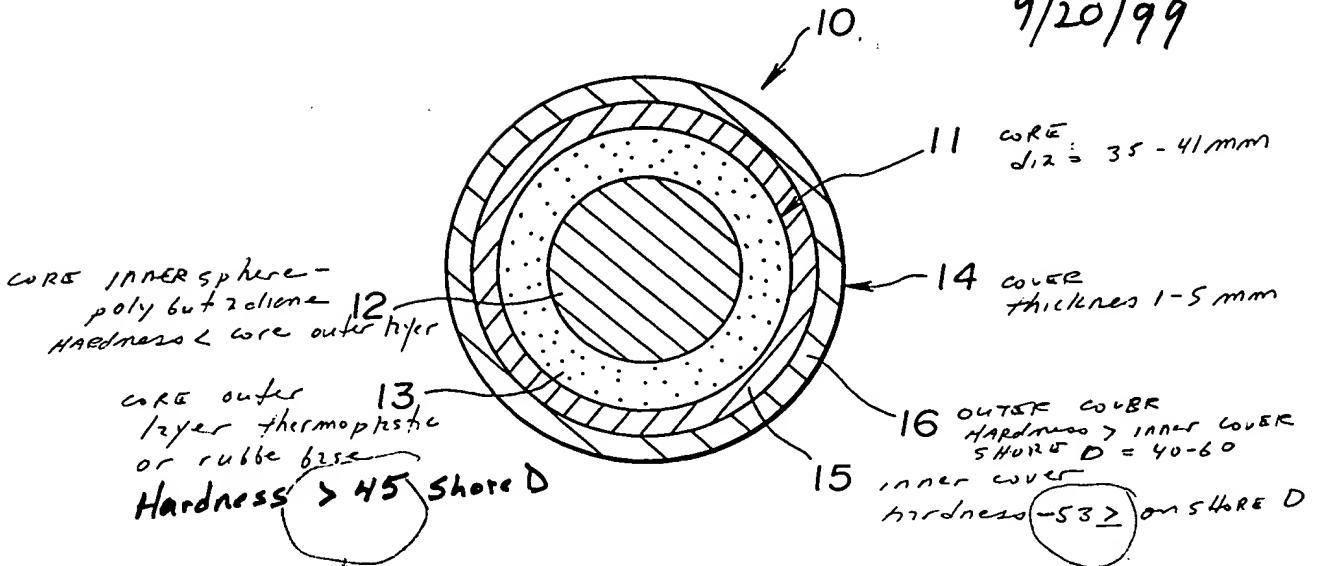


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Not
Approved
LJM

9/20/99

FIG.2



claim says
at least 45
Not greater than 45